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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/240,524

01/29/99

GERNDT

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QM02/1213

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EXAMINER

ATKINSON, C

ART UNIT

PAPER NUMBER

3743

DATE MAILED:

12/13/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/240,524

Applicant(s)

Gerndt et al.

Examiner

Atkinson

Group Art Unit

3743

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 10/10/2000.
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-20 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-20 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit: 3743

Response to Amendment

Applicant's arguments filed 10/10/2000 have been fully considered but they are not persuasive.

Double Patenting

Claims 23 and 25 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 22 and 24 respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 8-9, 14 and 18-21 are rejected under 35 U.S.C. § 102(b) as being anticipated by Seanor.

The patent of Seanor in Figures 1-7 discloses the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3743

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

Claims 5-7, 10-12, 15-17 and 22-25 are rejected under 35 U.S.C. § 103 as being unpatentable over Seanor.

The patent of Seanor discloses all the claimed features of the invention with the exception of the claimed number of channels. The claimed number of channels is considered to be an obvious design choice which does not solve any stated problem or produce any new and/or unexpected result.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have two rollers, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193

Art Unit: 3743

USPQ 8.

Claim 13 is rejected under 35 U.S.C. § 103 as being unpatentable over Seanor in view of Eriksen et al. The patent of Seanor discloses all the claimed features of the invention with the exception of a spiral channel.

The patent of Eriksen et al. in Figure 5 discloses a spiral fluid flow channel for the purpose of reducing flow resistance. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to employ in Seanor a spiral fluid flow channel for the purpose of reducing flow resistance as disclosed in Eriksen et al.

Response to Arguments

Applicant's concerns directed toward the objected to claims under 37 CFR 1.75 are not found persuasive. Claims 23 and 25 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 22 and 24 **respectively**. Therefore, claim 23 is a substantial duplicate of claim 22 and claim 25 is a substantial duplicate of claim 24.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e. fluid evenly distributed, uniform heat transfer and the journal to transfer fluid from one end to the opposite end of the heat exchanger) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's concerns directed toward Seanor are not found persuasive. Seanor, in Figures

Art Unit: 3743

1 and 4, discloses a thermal transfer roller (1) having an outer shell/circumferential surface (2,2c), an inner shell (inner circumferential surface located inside and parallel to the outer shell/circumferential surface) and an annulus (3c,4, the ring like part/open space, which is the definition of an annulus, where fluid flows between the inner and outer shells illustrated in Figures 1 and 4) therebetween. Only independent claim 14 requires a roller journal and Seanor, in Figures 1 and 4, discloses a roller journal (8,8c). The claims do not require the inner and outer shells to be two separate shells nor do the claims require the annulus to be the only space between the shells.

Applicant's concerns directed toward the claimed number of channels are not found persuasive. The claimed number of channels is considered to be an obvious design choice in view of the number of channels disclosed in Seanor which does not solve any stated problem or produce any new and/or unexpected result. The number of channels are chosen only for a general desired degree of fluid flow. No unexpected result occurs with the number of channels being 10, 20 or 30 relative to the number of channels disclosed in Seanor.

In response to applicant's argument regarding Eriksen et al., the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Eriksen et al. in Figure 5 discloses that it is known to have a spiral fluid flow

Art Unit: 3743

channel for the purpose of reducing flow resistance. Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to employ in Seanor a spiral fluid flow channel for the purpose of reducing flow resistance as disclosed in Eriksen et al.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Atkinson whose telephone number is (703) 308-2603.

Christopher Atkinson
C.A.

December 12, 2000

CHRISTOPHER ATKINSON
PRIMARY EXAMINER